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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,851	10/08/2004	Reinhard Berger	LUKP:126US	5850
24041	7590	11/30/2005	EXAMINER	
SIMPSON & SIMPSON, PLLC 5555 MAIN STREET WILLIAMSVILLE, NY 14221-5406			LEWIS, TISHA D	
			ART UNIT	PAPER NUMBER
			3681	
DATE MAILED: 11/30/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/711,851

Applicant(s)

BERGER ET AL.

Examiner

TISHA D. LEWIS

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 11-15 and 19-24 is/are rejected.
- 7) ☒ Claim(s) 9, 10, 16-18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

The following is a response to the amendment received on September 8, 2005 which has been entered.

#### ***Response to Amendment***

Claims 1-24 are pending in the application.

-The objection to claims 10, 21, 23 and 24 has been withdrawn due to applicant correcting the typographical and grammar errors.

#### ***Response to Arguments***

Applicant's arguments, see pages 6-8, filed September 8, 2005, with respect to the Stork reference lacking the starter generator turning the engine on during a moment when the gearbox clutch slips have been fully considered and are persuasive. The 102(a) and 103(a) rejections of claims 1-24 has been withdrawn.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 14, 15, 19, 20 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 19917665A1 (US 6,705,416) in view of Boll ('470).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

DE discloses a motor vehicle having an electrical machine (4) arranged between an engine clutch (7), a gearbox clutch (8), a drive unit (2), a clutch gearbox (3) and a power take off shaft (5) wherein the machine (4) is used to start the engine (2) with a slipping of the clutch (7) according to a speed value and temperature factor determined by a controller, but does not disclose the gearbox clutch slipping.

Boll discloses a motor vehicle having an electrical machine (EM2) arranged between an engine clutch (10), a gearbox clutch (24), a drive unit (4), a clutch gearbox (26) and a power take off shaft wherein the gearbox clutch is used in a continuous slipping mode.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the gearbox clutch of DE in a continuous slipping mode in view of Boll to avoid thermal overload of the clutch and electric machine.

Claims 3, 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE in view of Boll as applied to claims 1 and 22 above, and further in view of Hohn. DE in view of Boll discloses an engine starting arrangement, but does not disclose fuel/gas controlled by a controller to start the engine.

Hohn discloses a drive assembly wherein an electric machine is used to start an engine while a kickdown switched is turned on and an extreme acceleration is determined (gas pedal exceeds position, high fuel consumption) (column 2, lines 31-39).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the engine of DE in view of Boll started with a kickdown

switch turned on in view of Hohn to reduce the speed output of the engine to provide smooth transformation between the electric motor drive mode to the engine drive mode.

***Response to Arguments***

Applicant's arguments filed September 8, 2005 have been fully considered but they are not persuasive.

As to applicant's argument that the Glonner et al reference does not teach a clutch between a generator and a crankshaft, the reference does suggest in column 5 lines 44-45, that the machine 4 can be also used as a generator.

As to applicant's argument that the Boll reference only teaches an electric motor, the reference does suggest in column 4, lines 40-42, that the motor can be used as a generator.

As to applicant's argument that the Glonner et al and Boll references do not turn on a drive unit during a slipping state, the Glonner et al references does disclose that the clutch 7 does slip during an engine starting, column 4, lines 35-37 wherein the electric motor 4 causes the clutch to slip and not the engine as suggested in applicant's arguments on page 9, lines 18 and 19. The claims 1 and 22 do not suggest that the engine is started in response to clutch slipping, but rather that the engine is started in response to the starter generator at a moment when the clutch is slipping (does not suggest that the clutch has to be slipping in order for the engine to start).

Glonner et al already teaches that an engine clutch slips during engine starting by an electric motor/generator and that a gearbox clutch slips during a start from vehicle rest and since the gearbox clutch already has a slipping function it would be obvious to

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have that clutch also provided as a slipping clutch when both the electric machines (4 and 6) are needed to start the engine. Boll is used to show that a gearbox clutch can provide a continuous slipping function wherein the term "continuous" would suggest that the slipping will occur even at engine starting by the electrical motor.

As to applicant's argument about the Hoehn reference, this reference was used to show that the limitations of claims 3, 4 and 7 are not novel and not as what applicant is arguing it doesn't teach (page 10, lines 20 and 21).

### ***Allowable Subject Matter***

Claims 9, 10 and 16-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### **FACSIMILE TRANSMISSION**

Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 872-9326 before final and 703-872-9327 after final**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to  
the Patent and Trademark Office (Fax No. (703) 000-0000) on \_\_\_\_\_ (Date)

Typed or printed name of person signing this certificate:

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(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to TISHA D. LEWIS whose telephone number is 571-272-7093. The examiner can normally be reached on M-Thur 6 AM TO 2:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES A. MARMOR can be reached on 571-272-7095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tdl  
November 28, 2005

  
TISHA LEWIS  
PRIMARY EXAMINER  
AU 3681 11/28/05